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REMARKS

In the Office Action, claims 12-15, 17, 18, 20-23, 25, and 26 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

In the Office Action, claims 1-5 and 8-26 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Number 6,456,882 to Schloss.

In the Office Action, claims 6 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schloss in view of U.S. Patent Number 6,584,355 B2 to Stessman .

In response thereto, claims 12, 14, 15, 17, 18, 20, 22, 23, 25, and 26 have been amended. Accordingly, claims 1-26 are pending. Following is a discussion of the patentability of each of the pending claims.

Preliminary Matter

In response to the rejections under 35 U.S.C. §112, second paragraph, the following amendments have been made:

claim 12, line 1, "first" has been deleted;

claim 14, line 1, "second" has been deleted;

claim 15, line 1, "second" has been deleted;

claim 17, line 1, "first" has been deleted;

claim 18, line 1, "second" has been deleted;

claim 20, lines 1-2, "first memory means stores" has been replaced with --means for storing a number of backup stimulation pulses comprising storing--;

claim 22, lines 1-2, "second memory means stores" has been replaced with --means for storing a number of primary stimulation pulses comprises storing--;

claim 23, lines 1-2, "second memory means stores" has been replaced with --means for storing a number of primary stimulation pulses comprises storing--;

claim 25, lines 1-2, "first memory means stores" has been replaced with --means for storing a number of backup stimulation pulses comprises storing--; and

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claim 26, lines 1-2, "second memory means stores" has been replaced with — means for storing a number of primary stimulation pulses comprises storing—.

Independent Claim 1

Claim 1 recites a method of monitoring the performance of an automatic capture verification feature in a cardiac stimulation device. The method comprises monitoring the number of backup stimulation pulses delivered and storing the number of backup stimulation pulses delivered, monitoring the number of primary stimulation pulses delivered at each of a plurality of stimulation output settings and storing the number of primary stimulation pulses at the respective output settings, and comparing the stored number of backup stimulation pulses to the stored number of primary stimulation pulses to evaluate the performance of the automatic capture verification feature.

Without addressing the merits of the rejection of the pending claims, in accordance with the American Inventors Protection Act, the Schloss reference does not qualify as prior art for a rejection under both 35 U.S.C. §102(e) and 35 U.S.C. §103(a) via 35 U.S.C. §102(e) because the present application has been filed on or after November 29, 2000 and the subject matter of the Schloss reference and the pending claims were, at the time the invention was made, subject to an obligation of assignment to the same organization (see section entitled "Obligation of Assignment to the Same Organization"). Accordingly, the Schloss reference no longer qualifies as prior art under both 35 USC §102(e) and 35 USC §103(a) via 35 USC §102(e).

The Stessman reference is directed to measuring current drain or charge depletion for implantable medical devices. In one embodiment, an oscillating output is provided with a frequency of oscillation that is dependent on a pulse generator current I_{PG} . An oscillation count is provided or determined for the oscillating output, and the pulse generator current I_{PG} is determined based on the oscillation count over a period of time. Charge depletion of a battery is determined by continuously summing the oscillation count over successive periods of time.

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No where does the Stessman reference disclose or suggest comparing the stored number of backup stimulation pulses to the stored number of primary stimulation pulses to evaluate the performance of the automatic capture verification feature. In the Stessman reference, the degree of battery depletion is determined by summing the oscillation count over successive periods of time such that primary stimulation pulses are not distinguished from backup stimulation pulses.

As stated in the specification, the present application is directed to providing a diagnostic tool capable of distinguishing between safety backup pulses delivered at a high output setting from primary stimulation pulses delivered at the same high output setting. This information may be useful in assessing the performance of automatic capture verification by documenting how often safety, backup pulses are required. This information would also be valuable to a clinician in selecting programmed output settings and working margins.

Accordingly, it is respectfully submitted that claim 1 is in condition for allowance.

Dependent Claims 2-9

Claims 2-9 depend from claim 1 and are similarly patentable. Accordingly, it is respectfully submitted that these claims are in condition for allowance.

Independent Claim 11

For at least the same reasons discussed above with regards to claim 1, it is respectfully submitted that claim 11 is in condition for allowance.

Dependent Claims 12-18

Claims 12-18 depend from claim 11 and are similarly patentable. Accordingly, it is respectfully submitted that these claims are in condition for allowance.

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BEST AVAILABLE COPYIndependent Claim 19

For at least the same reasons discussed above with regards to claim 1, it is respectfully submitted that claim 19 is in condition for allowance.

Dependent Claims 20-26

Claims 20-26 depend from claim 19 and are similarly patentable. Accordingly, it is respectfully submitted that these claims are in condition for allowance.

Obligation of Assignment to the Same Organization

Ronald Tamura, an attorney of record for the present application, states that Application Serial Number 09/964,225 and U.S. Patent Number 6,456,882 B1 to Schloss were, at the time the invention of Application Serial Number 09/964,225 was made, owned by Pacesetter, Inc. or subject to an obligation of assignment to Pacesetter, Inc. Submitted herewith is Exhibit A, which is the recorded Assignment for U.S. Patent Number 6,456,882 B1 and Exhibit B, which is the recorded Assignment for the present application Serial Number 09/964,225.

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CONCLUSION

In light of the above claim amendments and remarks, it is respectfully submitted that the application is in condition for allowance, and an early notice of allowance is requested.

Respectfully submitted,

2/26/04

Date

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Enclosures: Exhibits A and B